

Attorney Docket No. LWEP:121US
U.S. Patent Application No. 10/735,394
Reply to Office Action of October 17, 2005
Date: January 17, 2006

Remarks

Amendments to Claims 1 and 2

Applicants have amended Claim 1 to more clearly describe and claim the invention of that claim. Applicants have deleted the term optomechanical and inserted the term “optical and mechanical” in its place to describe and claim the types of adaptation of the module of the inverted microscope. Support for this amendment can be found in the paragraph 0013 of the specification describing the optical and mechanical adaptation of the module achieved by use of horizontal changing surface 3. As explained in paragraph 0013 and seen in comparing Figures 1 and 2, it is seen that module 4 is rotated 180° into the plane of the drawing sheet 2 while the stand 2 is rotated only 90° thereby creating a different orientation of module 4 in relation to housing 2 as compared to Figure 1. It is also evident from Figure 2 that module 4 is placed back on horizontal changing surface 3 of housing 2. Therefore, it can be seen that module 4 is adapted mechanically by rotating it 90° and placing it back onto horizontal changing surface 3. The module is adapted optically by changing the path of light beam 10 to reach the binocular tube and photo tube even though the orientation of the binocular tube and photo tube is changed.

Applicants have also amended Claim 2 to more clearly claim the invention of that claim. Applicants have deleted the terms “corresponds to” and the second “apparatus” for the terms “is received by” and “surface”, respectively. As is seen in Figures 1 and 2, horizontal protruding base unit (5) of module (4) is shown to fit into or be received by horizontal changing surface (3). Applicants courteously point out that in original Claim 2, the horizontal changing apparatus had the same part number, 3, as the horizontal changing surface of independent Claim 1 and amended Claim 2 thus denoting it refers to the same claim element.

The 102 (e) Rejections of Claims 1-5 and 8-18

The Examiner has maintained the rejection of Claims 1-5 and 8-18 as anticipated by U.S. Patent Publication No. 2002/0131165 to Takahama (“Takahama” or “the Takahama publication”). Applicants have amended Claim 1 of the application. Applicants respectfully traverse the rejection of amended Claim 1 and request reconsideration.

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“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131. (Emphasis added.) Applicants have amended Claim 1 to more clearly claim the invention in which a horizontal surface on the microscope stand is used to adapt both optically and mechanically the module attached to the housing on the horizontal changing surface. As discussed below, Applicants respectfully point out that mirror 51 in Takahama cannot adjust the module optically when t is a horizontal position module and cannot adjust the module mechanically as the mirror in Takahama is not used in any way to provide a surface for a change in the physical orientation of the module to the housing. Applicants respectfully note that a single claim element in Claim 1, namely the horizontal changing surface (3), is claimed as providing both mechanical and optical adaptation of the module. The Takahama patent only provides components that adapt a module either optically or mechanically, but not both. For this first reason, Applicants respectfully submit that Takahama fails to anticipate amended Claim 1 as it fails to provide a single component that provides both optical and mechanical adaptation of a module.

In addition, Applicant respectfully points out that the Takahama patent must disclose all the elements of Claim 1 as arranged in that claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Applicants courteously note that the changing surface claimed in Claim 1 is a horizontal changing surface. By horizontal is meant parallel to the base of the microscope housing of which it is a part. Applicants note that the Examiner has stated that mirror 51 in Takahama is a horizontal changing surface. In the Examiner’s Response to Arguments, the Examiner states that mirror 51 provides for deflecting light from a horizontal direction to another direction. First, Applicants respectfully note that the term “horizontal” in Claim 1 refers to the changing surface itself, not the direction or orientation of any other element. Second, Applicants respectfully submit that *arguendo* if the mirror was a horizontal changing surface, which it is not, it would not be able to reflect light if it was in a horizontal orientation. If mirror 51 in Takahama is in a horizontal orientation, parallel to the base of the stand, it would

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not be able to reflect light to the module as the light would bounce back toward light source 31. For that reason, it would not be able to optically adapt module 54 as in the horizontal position light would not travel from mirror 51 to module 54. In addition, in the horizontal orientation, it would not be able to reflect light from the module to any other direction. Thus, again it is not able to optically adapt module 54. For this additional reason, because mirror 51 cannot optically adapt module 54 in the horizontal position, as claimed in Claim 1, it fails to anticipate amended Claim 1.

Furthermore, Claim 1 claims an invention in which the horizontal changing surface provides for mechanical adaptation of a module. In his response to arguments, the Examiner states that mirror 51 is shown to pivot about an axis orthogonal to the beam path requiring mechanical movement of the mirror. However, Claim 1 is directed to a mechanical adaptation of the module, not the horizontal changing surface itself. Applicants respectfully point out that horizontal changing surface 3 on the microscope stand 2 does not change its orientation in relation to the stand when module 4 is removed from the horizontal changing surface, turned, and attached back to the horizontal changing surface as explained in paragraph 0013 of the specification. For this additional reason, because mirror 51 cannot mechanically adapt module 54 whether in a horizontal or other position, Takahama fails as a reference under § 102 (e).

Thus, the Takahama patent fails to anticipate Claim 1 as it fails to disclose each element of Claim 1 as arranged in that claim. First, mirror 51 does not provide any means to both optically and mechanically adapt the module as claimed in amended Claim 1. Second, the mirror cannot provide optical adaptation to the module when it is in the horizontal position. Third, the mirror does not provide any way of enabling a mechanical change or adaptation in the module or the module's attachment to the microscope stand. For these reasons, the Applicants respectfully submit that the Takahama fails as a reference under § 102 (e) as it fails to disclose each element of Claim 1. Applicants respectfully request reconsideration and allowance of Claim 1.

Claims 2-5 and 8-18 depend directly or indirectly from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the Takahama patent fails to anticipate all the elements of Claim 1, it also fails to anticipate Claims 2-5 and 8-18. Applicants

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respectfully request the removal of the rejections of Claims 2-5 and 8-18 and allowance of those claims.

In addition, Applicants specifically traverse the rejection of amended Claim 2. Claim 2 explicitly claims the invention in which the module possesses a fitting or “changing apparatus” (9) to fit onto the horizontal changing surface of the microscope housing. Applicants respectfully submit that Takahama does not show a horizontal changing surface that allows attachment of a module to a housing and enables a change in the orientation of the module to the housing by receiving the module in a new physical position (mechanical adaptation) and enables optical adaptation of the module. For this additional reason, Applicants respectfully traverse the rejection of amended Claim 2 and request reconsideration and allowance of Claim 2. Applicant notes that the module changing apparatus (53) designated by the Examiner as analogous to the horizontal changing surface of amended Claim 2 is in actuality a relays lens group and not a surface at all. In addition, it provides no means for mechanical adaptation of a module.

Claims 8, 11, 12, and 15 depend directly or indirectly from Claim 2 and thus incorporate all the limitations of that claim. Because, as discussed above, the Takahama patent fails to anticipate all the elements of Claim 2, it also fails to anticipate Claims 8, 11, 12, and 15. Applicants respectfully request the removal of the rejections of Claims 8, 11, 12, and 15 and passage to allowance of those claims.

The § 103 (a) Rejections of Claims 6, 7, and 19-48

The Examiner rejected Claims 6, 7, and 19-48 under 35 U.S.C. § 103 (a) as obvious over the Takahama patent. Applicants note that Claims 6, 7, and 19-48 depend directly or indirectly from amended Claim 1 and thus incorporate all the elements of that claim. Applicants respectfully traverse the rejection of Claims 6, 7, and 19-48 and request reconsideration.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In addition, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion

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to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Claims 6, 7, and 19-48 each claim an inverted microscope having a housing or stand that includes a horizontal changing surface to optically and mechanically adapt a module.

Applicants note that Takahama does not teach or suggest any single component that allows both the mechanical or optical adaptation of a module. In addition, the components designated by the Examiner as analogous to the claimed horizontal changing surface, mirror 51 and relay lens group 53, provide no means of mechanical adaptation of the module. Moreover, as discussed above, mirror 51 cannot provide optical adaptation such as a changed beam path when in the horizontal position. Therefore, because Takahama fails to disclose, teach, or suggest a single horizontal component with a surface that enables both the optical and mechanical adaptation of a module, it fails to render obvious Claims 6, 7, and 19-48. Applicants respectfully request reconsideration and allowance of Claim 6, 7, and 19-48.

In addition, Applicants respectfully traverse the rejection of Claims 19, 23, 26, 27, 30, 33, 34, 38, 41, 42, 45, and 48 as obvious over Takahama. Claims 19, 23, 26, 27, 30, 33, 34, 38, 41, 42, 45, and 48 depend directly or indirectly from amended Claim 2 which claims a module with an apparatus (9) that fits into the claimed horizontal changing surface. Nowhere in Takahama is there a suggestion or teaching of a component having a horizontal surface that receives an apparatus of a module that is able to fit into that horizontal changing surface thereby enabling both optical and mechanical adaptation. For these additional reasons, Applicants respectfully traverse the rejections of Claims 19, 23, 26, 27, 30, 33, 34, 38, 41, 42, 45, and 48. Applicants respectfully request reconsideration and allowance of Claims 19, 23, 26, 27, 30, 33, 34, 38, 41, 42, 45, and 48.

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Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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